

REMARKS

In response to the above-noted Office Action, Applicant has elected Invention I, Claims 90-154, drawn to a document generation system including a generation component, classified in class 715, subclass 513, with traverse. Claims 155-178 are withdrawn. In the Action, the Examiner only references Claims 90-173. However, since the pending claims are 90-178, it is assumed that claims 174-178 were intended to be included in Invention III.

In support of the traverse, Applicant notes, at page 2 of the Action, numbered paragraph 2, the Examiner asserts the following:

Inventions I, II and III are related as sub-combinations disclosed as usable together in a single combination. The sub-combinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one sub-combination is separately usable. In the instant case, sub-combination II has separate utility such as editing word processing data.

However, Applicant notes that all of the claims relate to XML documents, and therefore fall within subclass 513. In addition, all of the claims relate to document assembly and therefore fall within subclass 520. Consequently, all of the claims share the same class and subclasses and do not require separate searches, for the following reasons.

The first group of claims is said to belong to subclass 513, which relates to a “document . . . created and processed according to a standardised of interrelated hierarchical flow and page layout.” Although XML is undoubtedly structured, the subclass refers to “flow and page layout”, which suggests the physical arrangement of text on a page, whereas it seems that the XML defines a logical structure, rather than a page layout structure. However, whether relating to page layout or otherwise, this class is commonly used for XML-based inventions.

The second group of claims, consisting only of claim 155, is said to belong to subclass 530, which relates to “means or steps for developing or changing a document wherein one or more elements of a document are added, deleted, or modified.” This is also an accurate description of document assembly, and therefore applies, not only to claim 155, but to all of the claims.

The third group of claims is said to be classified in subclass 522 which relates to “subject matter wherein layout specifications are stored separately from the data to which such specifications are applied.” While this may be the case in terms of what the system actually does in practice, the invention, as defined in independent claim 156, or in any of the claims, does not refer to or require any layout specifications, as the invention relates rather to content assembly, such as what text to include or exclude from a specific document, and not how that text is laid out or formatted.

Accordingly, Applicant does not believe that subclass 522 applies to at least the independent claims, but believes that all of the claims fall within subclass 513 and possibly 530 of class 715.

On page 2 of the Office Action, the Examiner states:

“subcombinations are distinct if:

- (i) they do not overlap in scope; and
- (ii) are not obvious variants; and
- (iii) if it is shown that at least one subcombination is separately usable.”

However, the only specific argument provided by the Examiner is his statement that “in the instant case, sub-combination II has separate utilities such as editing word processing data.” The Examiner appears to have ignored his other two requirements for distinctness. In particular, it seems clear that all three independent claims overlap in scope. For example, independent claims 90 and 155 only differ in minor aspects. Both claims refer to “generating” (claim 155) or “determining content of” (claim 90) “an instant document” from an XML source document. Both claims recite “generating an XML source document by associating an initial XML document with” either “one or more logic sources” (claim 90), or “logic” (claim 155). Both claims require “said initial XML document and said XML source document both being valid with respect to the same predetermined DTD or schema.” Therefore, it should be clear from this that claims 90 and 155 are very similar and overlapping scope.

With regard to claim 156, there is no feature in this claim that is not also included in independent claim 90.

If there are any fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

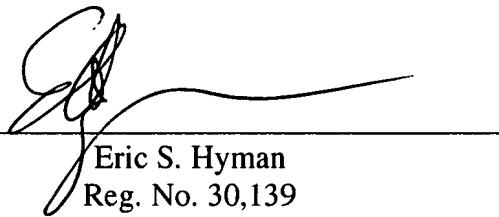
Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN

Dated:

10/16/07

By: _____

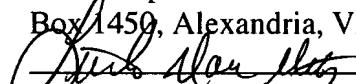
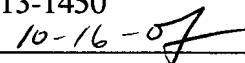


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Linda Marie Metz October 16, 2007